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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,363	01/26/2001	Yoshihiro Ishida	35.G2725	4785

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FITZPATRICK CELLA HARPER & SCINTO
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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/769,363

Applicant(s)

ISHIDA ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,9,12,13,17,18,20 and 23 is/are rejected.
- 7) ☒ Claim(s) 5, 8, 10-11, 16, 19, and 21-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

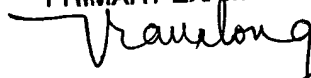
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 12/28/06.
- Claims 1-2, 5-13, 16-23 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-7, 9, 12-13, 17-18, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5621810), and in view of Yamakawa et al (US 5809366).

Regarding claim 1, Suzuki discloses an image processing apparatus (*copy machine, fig. 2*), comprising:

- image-data input means (*image scanner 201, fig. 2, col. 4, lines 1-20*) for inputting image data;
- specific-image determination means (*prohibition pattern detection means, fig. 36, col. 2, lines 1-50 and col. 4, lines 36-64*) for determining whether the image data input by said image-data input means represents a specific image having predetermined characteristics (*i.e. digital watermark, figs. 14-15*);

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• difficulty determination means (*detection means, col. 2, lines 3-5 for calculating a mounting position of a document detecting the positioned state of an original image/document, col. 4, lines 45-52*), wherein said difficulty determination means determines whether the determination by said specific-image determination means is difficult by comparing information about the mounting position (*calculating angle of original with respect to platen surface via reading and/or detecting four corner coordinates A, B, C, and D as shown in fig. 11 & 14, see col. 8, lines 10-55 are calculated based upon these four detected coordinates, col. 8, lines 10-67 and col. 11, lines 28-32*) to a predetermined threshold (*angle of platen surface, theta of fig. 14a*).

However, Suzuki does not expressly disclose (1) re-input determination means for determining whether to output a signal urging re-input of the image data input by said image-data input means, wherein said re-input determination means determines whether to output the signal urging re-input of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means.

Yamakawa, in the same field of endeavor for printing, teaches (1) re-input determination means (image processor 3 of copy machine 1, fig. 4) for determining whether to output a signal urging re-input (warning message for urging user to execute scanning again, col. 14, lines 30-35) of the image data input by said image-data input means, wherein said re-input determination means determines whether to output the signal urging re-input (message urging re-scanning of image data, col. 14, lines 30-35) of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data (message urging re-scanning of image data, col. 14, lines 30-35) by said re-input determination means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image processing apparatus of Suzuki to include a re-input means for re-input original image to read again because of difficulty of reading the first scan as per teachings of Yamakawa because of a following reason: (•) to accurately

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detects security marks/originals by ensuring the inputted image is scanned correctly and accurately; (●) to obtain high quality of outputted documents if the documents are not copy-prohibited by ensuring the documents are properly read/scan.

Therefore, it would have been obvious to combine Suzuki with Yamakawa to obtain the invention as specified in claim 1.

Regarding claim 2, Suzuki further discloses an image processing apparatus according to claim 1, wherein said specific-image determination means determines whether the image data obtained from said image-data input means represents a copy-prohibition image (i.e. money, fig. 14a).

Regarding claim 6, Suzuki further discloses an image processing apparatus according to claim 2, wherein said difficulty determination means (col. 2, lines 1-50 and cols. 9-10) determines whether it is difficult for said specific-image determination means to determine whether the image is a copy-prohibited image (i.e. digital watermark, figs. 14-15) based on the difficulty calculated by said difficulty.

Regarding claim 7, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether the re-input is to be urged, from data based on a position of an original (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) in an image represented by the input image data.

Regarding claim 9, Suzuki further discloses an image processing apparatus according to claim 6, wherein said difficulty calculation means calculates the difficulty in the determination of a copy-prohibition image, from data based on a position (position calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination of a copy-prohibition image is difficult, by comparing data of the difficulty calculated by said difficulty calculation

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means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claims 12-13, 17-18, and 20: Claims 12-13, 17-18, and 20 are the method claims corresponding to the apparatus claims 1-2, 6-7, and 9. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-2, 6-7, and 9 above for more details.

Claim 23 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs; therefore, claim 23 would be rejected using the same rationale as in claim 1.

Allowable Subject Matter

Claims 5, 8, 10-11, 16, 19, and 21-22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten (allowable subject matters as cited in claims 5 & 16 contain) in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

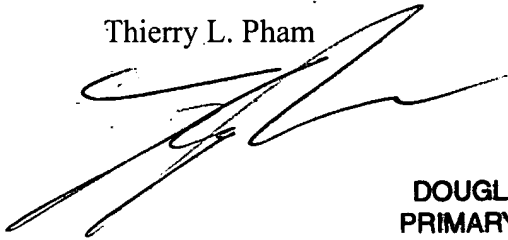
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



DOUGLAS Q. TRAN
PRIMARY EXAMINER

